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Application No.:10/733,419
Filed December 11, 2003
Amendment dated July 24, 2007

Remarks/Arguments

The amendment to claim 119 adds classes of lubricants supported by the dependent claims previously examined. The amendment to claim 123 describes solid organic lubricants such as fluoroalkylene polymers and the like supported by claim 124, now cancelled without prejudice or disclaimer. The amendments to claim 125 describe the various lubricant-water combinations of the invention comprising a petroleum oil or greases thereof and water, or a synthetic grease and water, or a solid inorganic lubricant and water. Claims 126 and 127, inter alia, now cancelled without prejudice or disclaimer, support these amendments. The amendment to claim 125 includes two classes of phosphate lubricants comprising trialkyl phosphates and triaryl phosphates which the written description supports on page 12, first full paragraph. The amendment to claim 132 describes the lubricant as a synthetic oil grease, terminology used in this claim prior to amendment.

The examiner rejects claims 119-133 on ground of provisional double patenting in view of United States Patent No. 6,734,147, and United States Patent Applications Serial Nos. 08/943,125 and 10/781,240. Applicant submits a Terminal Disclaimer with this amendment to address these rejections and requests the examiner to withdraw the double patenting rejections.

The examiner also rejects claims 119-133 under 35 USC §§ 102(e) and 103(a) as anticipated by or obvious in view of United States Patent No. 5,626,154, Rogers et al. ("Rogers"). Applicant traverses the rejection and requests further consideration and reexamination.

Rogers does not teach or suggest any of the novel lubricant compositions of the claims as amended, namely, Rogers fails to teach the superabsorbent polymers of the invention in

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combination with the lubricants of claim 119 and the other claims of the invention comprising:

- (a) a solid inorganic lubricant;
- (b) a petroleum oil or grease thereof;
- (c) a petroleum oil or grease thereof with water;
- (d) a synthetic oil grease with water;
- (e) a solid inorganic lubricant with water;
- (f) a phosphate;
- (g) a fatty oil;
- (h) a synthetic oil grease
- (i) a synthetic oil grease; or
- (j) a soap.

Rogers lacks any teaching, suggestion or motivation to employ the foregoing lubricants in a composition whose sole disclosed function consists of enhancing "shaving systems . . . of the wet shave type, [that address] factors such as the frictional drag of the razor across the face, the force needed to sever hairs, and irritation of preexisting skin damage [that] can create a degree of shaving discomfort." (Rogers, col. 1, lines 5-9). Surely, the skilled artisan, after considering the Rogers "shaving system" would not have conceived of systems comprising a superabsorbent polymer with a solid inorganic lubricant; a petroleum oil or grease thereof; a petroleum oil or grease thereof with water; a synthetic oil grease with water; a solid inorganic lubricant with water; a phosphate; and the like.

The Rogers teachings comprise non-analogous art, addressed by The Court of Appeals for the Federal Circuit in many instances. They observed for example:

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It has not been shown that a person with ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to a fastener for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion or motivation found in the prior art whereby a person with ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992). (Emphasis added)

(Citations omitted)

As in Oetiker, the examiner reconstructs applicant's lubricant invention from Rogers' "shaving system" with the benefit of hindsight without any reason, suggestion or motivation to make this construction, especially where Rogers lacks any teaching of the lubricants now claimed.

Applicant therefore requests the examiner to pass the present claims to issue for these and the other reasons set forth in this amendment.

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Dated July 24, 2007

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Dated July 24, 2007

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